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Application/Control Number 10/647,618

Art Unit:3634

Applicant respectfully submits that the Examiner has improperly made this a Final Office Action because the rejection of Claim 6 on the merits was not necessitated by any amendment made by Applicant and this is the first time this issue has been raised by the Examiner. Accordingly, withdrawal of the characterization of this Action as being Final is respectfully requested.

However, the following remarks are provided in response to the Examiner's characterization of this Action as Final Rejection of all pending claims in the above-identified application in anticipation of Applicant filing a Notice of Appeal From the Examiner To The Board of Patent Appeals.

Accordingly, reconsideration and withdrawal of the various rejections of the pending claims in the present application are respectfully requested in light of the following remarks.

Claim 6 has been rejected under 35 USC 112, first paragraph, for allegedly failing to comply with the enablement requirement because the Examiner has asserted that the claim contains subject matter that was not described in the Specification in such a way as to enable one skilled in the art to make the invention. This rejection is respectfully traversed and reconsideration requested in light of the following remarks.

The Examiner is reminded that the Claims as originally filed comprise part of the disclosure of the Application and that Claim 6 presently stands in its original form without any amendments by Applicant.

Claim 6 as originally filed states:

6. (Original) A decorative external curtain assembly according to Claim 1, wherein the complementary engageable fastener

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strips fasten more than one edge of the fabric material to  
the external façade of the building.

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Figure 2 of the Application, as originally filed, illustrates how one edge of the fabric material is fastened to the external façade of a building. Moreover, the Application, as originally filed, describes, beginning at page 7, line 14 and ending at page 8, line 16, how the edge of the fabric is attached to the building using VELCRO strips and hot glue and/or sewing. Specifically, the Application as originally filed states:

"Referring to Figure 2, the complementary engageable fastener strips from standing on the porch looking out, comprise complementary engageable fastener strips 21a, 21b, respectively attached to the fabric and the building, for affixing the decorative curtain assembly 11 to the external facade 15. The strips 21a, 21b preferably comprise, for example, VELCRO tape or strips having co-acting miniature hooks and loops formed of relatively rigid filament material. The decorative curtain assembly 11 is attached to the building using the action of the VELCRO™ strips 21a, 21b which adhere to together to create a strong attachment and yet temporary bond that is easily broken by simply pulling the two strips 21a, 21b apart."

As is well known, VELCRO the co-acting miniature hooks and loops, on separate side of the VELCRO strip, engage one another so that the VELCRO™ strips adhere together using the same action that is employed when a burr attaches itself to a piece of clothing or the like. One side of the strip 21a of the VELCRO tape is attached to the external facade 15 of the building 17 at the appropriate location, using, for example, any suitable existing adhesive or hot glue; while the other side of the strip 21b of VELCRO™ tape is either sewn or appropriately adhered, by hot glue or conventionally, in this instance, to top edge of the decorative fabric material 19.

In the embodiment illustrated in Figures 1 and 2, one of the VELCRO strips 21a is

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attached to an upper inside horizontal surface 25 of the porch 15 that un adjacent the ceiling of the porch and the other of the VELCRO strips 21b is attach 1 to the decorative fabric material 19 at least along one edge 23 thereof. The inventor has found that a VELCRO strip of about two inches wide is sufficient for affixing the decorative fabric material 19 to the external façade 15 of the building 17. "

Referring to Figure 2, as originally filed, one sees that the fabric has an additional (vertical) edge, for example, at the side which overlays the side (vertical) columns of the porch as seen in Figure 1. Thus, in the same manner as noted for the single edge of the fabric in the last paragraph quoted immediately above from the Application, any other edge of the fabric is attached to the building façade as specifically described in the Application, i.e., one side of the strip of the VELCRO tape is attached to the external façade of the building 17 at the appropriate location, using any suitable existing adhesive or hot glue; while the other side of the strip of VELCRO™ tape is either sewn or appropriately adhered, by hot glue or conventional adhesive, to an edge of the decorative fabric material.

In view of the foregoing, Applicant respectfully submits that the Application, as originally filed, clearly enables one of ordinary skill in the art to "fasten more than one edge of the fabric material to the building" without undue experimentation. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 1, 3 and 6-21 have been rejected under 35 USC 103(a) as unpatentable over Hillstrom in view of Phillips. In this rejection, the Examiner has alleged that: "... the fastener of Phillips is the same fastener used by Applicant and consequently

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capable of being used outside. Further, there is nothing in the  
description of the fastener of Phillips that would suggest that  
it is not usable outside." Art Unit:3634

This rejection and the Examiner's unsupported assertion that  
the Phillips reference teaches or suggests that the fastener of  
Phillips can be used outside are respectfully traversed and  
reconsideration requested.

Applicant respectfully submits that on the one hand the  
Examiner is mischaracterizing the teachings of Phillips as  
SUGGESTING the use of VELCRO fasteners to attach fabric to the  
outside of a building and on the other hand the Examiner has  
failed to consider or present evidence rebutting Applicant's Rule  
132 Affidavit which presents evidence refuting the Examiner's  
unsupported assertion that the prior art or the Phillips  
reference, alone or in combination, teaches or suggests the use  
of VELCRO strips to attach exterior curtains to the exterior of a  
building.

In addition, Applicant respectfully submits that the stated  
rejection is legally incorrect and improper because nothing in  
the cited references alone or in combination suggests or teaches the  
claimed invention and the rejection fails to satisfy its burden  
of establishing a prima facie case of obviousness by showing some  
teaching or generally available knowledge that would lead one  
skilled in the art to combine the teaching of existing references  
as proposed by the Examiner. In short, the Examiner CANNOT rely  
on Phillips to render the Applicant's invention obvious just  
because "... the fastener of Phillips is the same fastener used  
by Applicant and consequently capable of being used outside."  
This is clearly a hindsight reconstruction of the invention and  
improper as will be sustained by the Board on Appeal.

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More specifically, and as previously noted by Applicant, in contra-distinction to the present invention, Hillstrom discloses a conventional banner holding device having the deficiencies of the prior art noted by Applicant's Application because it uses a spring loaded metal frame device having a channel for holding the banner in place and overcome the forces of harsh weather conditions encountered at the exterior of a building.

The Hillstrom patent fails to disclose or suggest the use of complementary engageable fastener strips (VELCRO) having co-acting miniature hooks and loops formed of relatively rigid filament material for fastening the fabric material to the external façade of the building to create a temporary bond between the building and the fabric that is easily broken by pulling apart the strips as disclosed and claimed by Applicant.

Nor are the deficiencies of Hillstrom provided by Phillips which merely discloses the use of VELCRO to attach interior curtains to interior windows "in residences and commercial building" (See Column 1 lines 13-15.) where the curtain is NOT subject to harsh atmospheric weather conditions including the high winds such as experience by a banner mounted to the exterior of a building such as in Applicant's invention.

In addition, as clearly rebutted by Applicant's Rule 132 Affidavit filed with Applicant's previous response, Phillips does not relate to an arrangement for attaching an external curtain to the external façade of the building.

In addition, Hillstrom actually teaches away from the combination with the interior attachment arrangement of Phillips because exterior curtains are subject to atmospheric weather conditions such as wind and rain forces that do not in any way effect an interior curtain in the interior of a building and as

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noted by Hillstrom, at Column 1, lines 20-25, "Wh n the signs are  
positioned outdoors and subjected to harsh environmental  
conditions, known devices and systems have frequently proved  
unreliable." Art Unit:3634

In addition, as set forth in the Rule 132 Affidavit, in Applicant's experience:

"the idea that VELCRO™ tape could be effectively used to attach a curtain to the outside of a building where the curtain is subjected to harsh environmental conditions is unexpected because the general opinion in the art is that VELCRO would form too weak a bond to effectively hold the banner or curtain to the exterior of the building when harsh environmental conditions such as wind and rain are encountered by the exterior curtain."

Thus, in light of the remarks above, the rebuttal evidence presented by the Rule 132 Affidavit overcomes the Examiner's unsupported assertion that Phillips can be properly combined with the Hillstrom arrangement because there is no evidence or teaching in Phillips or any other cited reference to support the conclusion that the use of VELCRO™ tape to attach a curtain to the outside of a building would have been obvious. In fact, Hillstrom, when taken in combination with the assertions of the Rule 132 Affidavit, actually teaches away from the suggested combination with Phillips because on the one hand, Hillstrom notes that "When the signs are positioned outdoors and subjected to harsh environmental conditions, known devices and systems have frequently proved unreliable" and on the other hand the Rule 132 Affidavit states that the idea that VELCRO™ tape could be effectively used to attach a curtain to the outside of a building

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is "unexpected" and therefore, Hillstrom suggests that VELCRO  
would fail. Art Unit:3634

In fact, the only place that there is a disclosure or suggestion of the use of VELCRO to attach a exterior fabric, such as a banner to the exterior of the building is Applicant's Application as originally filed.

In view of the foregoing, Applicant respectfully submits that the stated rejection is both factually and legally incorrect. The Examiner is mis-relying or mischaracterizing the disclosure of Phillips as teaching the use of VELCRO fasteners to attach exterior curtains to the outside of a building and the Examiner has failed to consider Applicant's Rule 132 Affidavit which presents evidence rebutting the Examiner's unsupported assertion that the prior art teaches or suggests the use of VELCRO strips to attach curtains to the exterior of a building.

Accordingly, as a matter of law, this rejection is improper because: 1) the Examiner has failed to show any teaching or suggestion in the prior art that shows or suggests the use of or combination of VELCRO strips to attach exterior curtains to the exterior of a building; 2) the Examiner has failed to consider Applicant's Rule 132 Affidavit; 3) the Examiner has failed to present any evidence that overcomes the Applicant's Rule 132 Affidavit that states that, until Applicant's invention, VELCRO strips were not thought suitable for attaching decorative fabrics to the outside of a building; 4) the Rule 132 Affidavit has not been rebutted by the Examiner pointing to Applicant's disclosure to prove that the fastener of Phillips "is capable of being used outside"; and 5) nothing in the cited references alone or in combination suggest or teach the claimed invention and the

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rejection fails to satisfy its burden of establishing a prima facie case of obviousness by showing some teaching or generally available knowledge that would lead one skilled in the art to combine the teaching of existing references as proposed by the Examiner.

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In short, the Examiner CANNOT rely on Phillips as a teaching rendering the Applicant's invention obvious by referring to Applicant's own disclosure as proof that the "... the fastener of Phillips ...[is] capable of being used outside." This is clearly a hindsight reconstruction of the Invention and is proper.

In view of the foregoing remarks, Applicant respectfully submits that the Application is now in a condition for allowance and early notice of the same is earnestly solicited. However, in order to expedite the prosecution of the application for all concerned, the Examiner is invited to contact the undersigned should any questions arise.

Respectfully submitted,

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